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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,527	09/02/2003	Paul Pazandak	OBJS:002-C1	3355

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EXAMINER

FRANCIS, MARK P

ART UNIT	PAPER NUMBER
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2193

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/653,527

Applicant(s)

PAZANDAK, PAUL

Examiner

Mark P. Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/02/03</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the application filed on September 02, 2003.
2. Claims 1-10 have been examined.

Priority Date

3. The priority date considered for this application is February 09, 1999.

Oath/Declaration

4. The Office acknowledges receipt of a properly signed oath/declaration filed September 02, 2003.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1 and 3,

Regarding claims 1 and 3,

In this instance, the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to an environment or machine which would result in a practical application that would produce a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 USC 101.

According to the 101 Interim Guidelines, The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must

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operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."). "[An application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection." *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also *21 Corning*, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

Applicant defines a method for parsing an XML document, defining and associating type-specific objects with the XML document. Although the Applicant acquires the XML document and associates the XML document with a call, the claims never perform any data transformation that would produce a tangible result of a practical application and is considered to be non-statutory under 35 U.S.C. 101.

With respect to claim 2, this claim recites a system of parsing an XML document that comprises a computer that has code for operating the computer, means for calling the code and a class declaration locatable by the code. All of these steps can be implemented using software means only without the required use of a computer or a computer-readable medium.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Petty.
(U.S. Pat 6,342,907)

Independent claims

With respect to claim 1, Petty discloses a method of parsing an XML document, (Col 6:55-60, "...An XML document may be parsed...")comprising the steps of: defining type-specific object classes; (Col 7:7-23, "...Java class library...")
and associating the type-specific object classes with the XML document. (Col 4:32-45, "...collections of objects...some class...")

With respect to claim 2, Petty discloses a system of parsing an XML document, (Col 6:55-60, "...An XML document may be parsed...")comprising: a computer capable of

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receiving the XML document;(Col 6:56-67, "...An XML document may be parsed...", Col 8:1-12, "...Although computer system...")

a code for operating the computer; (Col 7:37-50, "...Panel conversion tool...")

means for calling the code; (Col 5:35-50, "...one object calling a method on another object...")

and a class declaration locatable by the code. (Col 7:7-23, "...a set of Java classes in a Java class library...", Col 8:45-55, "...such as remote procedure call...")

With respect to claim 3, Petty discloses a method of parsing an XML document, (Col 6:55-60, "...An XML document may be parsed...")comprising the steps of: acquiring the XML document; (Col 6:55-60, "...An XML document may be parsed...") associating the XML document with a call; (Col 7:7-23, "...a set of Java classes in a Java class library...", Col 8:45-55, "...such as remote procedure call...") calling a code; (Col 8:45-55, "...such as remote procedure call...") and creating a type specific object from the XML document because of the code. (Col 4:32-45, "...collections of objects...some class...")

With respect to claim 4, Petty discloses a method of generating type-specific objects from XML, (Col 6:55-60, "...An XML document may be parsed...") comprising the steps of:

calling a code that operates on XML; (Col 8:45-55, "...such as remote procedure call...")

processing the code; (Col 8:1-20, "...a single processor...")

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locating type-specific class associations; (Col 4:32-45, "...collections of objects...some class...")

locating the type-specific class code via the step of processing; (Col 4:32-45, "...collections of objects...some class...")

acquiring the type-specific class code via the step of processing; (Col 4:32-45, "...collections of objects...some class...")

parsing the XML to obtain the type-specific objects, (Col 6:55-60, "...An XML document may be parsed...") the step of parsing being dictated by the type-specific class declarations from the step of locating and according to a result of the step of processing. (Col 6:55-60, "...An XML document may be parsed...")

With respect to claim 5, Petty discloses a method of generating type-specific objects from a generic object, (Col 4:30-40, "...collections of objects...")comprising the steps of: creating an XML document; (Col 4:32-45, "...collections of objects...some class...") defining type-specific object classes corresponding to the type-specific objects; (Col 4:55-67, "...an object has two parts...")associating the type-specific object classes with the XML document;(Col 6:32-45, "...XML definition of PDML...") parsing the XML document to instantiate the type-specific object classes; (Col 6:55-60, "...An XML document may be parsed...") and obtaining the type-specific objects.

Dependent claims

With respect to claim 6, the rejection of claim 1 is incorporated and further, Petty discloses that the association is selected from the group consisting of explicit association and implicit association. (Col 4:32-45, "...collections of objects...some class...")

With respect to claim 7, the rejection of claim 6 is incorporated and further, Petty discloses that the explicit association is by specification via the XML document or a DTD of the XML document. (Col 6:56-67, "...The W3C defines certain standards to which XML parser...")

With respect to claim 8, the rejection of claim 6 is incorporated and further, Petty discloses that the implicit association is by publication of type-specific classes, locators, or links to the Internet, a database, or a query engine. (Col 6:45-56, "...XML is an evolving industry standard defined by the World Wide Web...")

With respect to claim 9, the rejection of claim 2 is incorporated and further, Petty discloses that the means is associated with XML document. (Col 6:55-60, "...An XML document may be parsed...")

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With respect to claim 10, the rejection of claim 4 is incorporated and further, Petty discloses that the step of parsing is dictated by intelligent parser or a parser that uses instantiation directives. (Col 6:55-67, "...there are a number of XML parsers...")

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark P. Francis whose telephone number is (571) 272-7956. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai T.An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark P. Francis

Patent Examiner

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~~MENG-ALAN~~
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100